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		Application Number	10/616,359
		Filing Date	July 9, 2003
		First Named Inventor	Bizzarro
		Art Unit	1626
		Examiner Name	Wright, Sonya N
Total Number of Pages in This Submission		Attorney Docket Number	20400 US6

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please Identify below): <input type="checkbox"/> Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Eileen M. Ebel
Signature	
Date	March 4, 2004

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Fred Thomas Bizzarro, et. al.

Group: 1626

Serial No. 10/616,359, filed July 9, 2003
Docket No.: 20400 US6

Examiner: Wright, Sonya N

For: HETEROAROMATIC GLUCOKINASE ACTIVATORS

RESPONSE UNDER 35 U S C § 121

Nutley, New Jersey 07110
March 4, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated February 6, 2004, Applicants provide the following remarks.

In response to the requirement for restriction, Applicants elect Group II, claims 1-149 and 267-278, directed to compounds of formula I wherein R⁴ is thiazole and thiadiazole.

In terms of a species election, Applicants request that the Examiner begin the search for compounds in which R² is methylsulfonyl, i.e., SO₂CH₃. Applicants identify species Example numbers 3, 12, 13, 89 and 97. In these Examples, R³

is cyclopentyl. In Examples 3 and 13, R¹ is hydrogen. In Examples 12 and 97, R¹ is Cl. In Example 89, R¹ is CF₃.

Applicants traverse the requirement for restriction, however.

The U.S. Patent Office is required to examine on the merits the entirety of generic claims. Applicants point out that it is well-established law that restriction within a single claim cannot be sustained under 35 U.S.C. §121. As is stated in *In re Weber*, 198 USPQ 328 (CCPA 1978), at pages 331-332:

"§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular *claim* on that same basis." (Emphasis in original text.)

If the Patent Office were to withdraw applicants' claims in part from further consideration due to an intra-claim restriction, the requirement amounts in fact to a rejection, see *In re Hass*, 179 USPQ 623, 625 (CCPA 1973).

Applicants have the right under U.S. patent law to claim their invention using the limitations that they regard as essential to delineate the invention, as long as the requirements of 35 U.S.C. §112 are met.

The law does not authorize the U.S. Patent Office to derive its own concept of a generic form of the claimed subject matter and require that it be carved out of existing claims. Applicants have the right under U.S. patent law to claim their invention using the limitations they provide to delineate the invention, as long as the requirements of 35 USC § 112 are met. See *In re Weber* at 331 and *In re Wolfrum and Gold*, 179 USPQ 620, 622 (CCPA 1973).

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Also, the Examiner is required to follow the U.S. Patent Office procedures set forth in MPEP § 809. The Examiner must perform a search for all claims readable on the elected species. The elected species should be examined. If the species is patentable, then the next species should be examined, and so forth, until an unpatentable species is found. If no species is found unpatentable, then the generic claim should be allowed.

Applicants request that the intra-claim restriction requirement be withdrawn.

It is believed that no fees are due. If a fee is owing, please charge our deposit account no. 08-2525

Respectfully submitted,



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